

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1, 3, 8, and 10 are pending in the application, with claim 1 being the independent claim. Claims 2 and 9 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Claims 4-7, 11-12, and 13- 21 have been withdrawn from consideration. Claims 1 and 3 have been amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Restriction Requirement

In the Office Action, the Examiner stated that claims 4-7 and 11-12 do not read on the elected species. Thus, the Examiner has withdrawn these claims from consideration. Applicants assert that claim 1 is generic and links to claims 4-7 and claims 11-12. Accordingly, applicants assert that claims 4-7 and 11-12 should be brought back into the instant application if independent claim 1 is found allowable. *See* MPEP 809.04.

Objection to Drawings

The Examiner has objected to the drawings under 37 C.F.R. 1.83(a) stating that the "drawings must show every feature of the invention specified in the claims." In particular, the Examiner states that "the multiple layer inductor implemented on a substrate must be shown." Applicants have amended FIG. 5 to include reference number 500 for clarification. Figure 5 illustrates a multiple layer inductor 500. Figure 5 is discussed in paragraphs 44-51 of the specification, where Paragraph 44 indicates that the multi-layer inductor is implemented on a substrate. Based on the foregoing arguments, Applicants submit that

amended FIG. 5 is in conformity with 37 C.F.R. 1.83(a).

Accordingly, based on the above, Applicants respectfully request that the objection be withdrawn.

Objection to Specification

In the Office Action, the Examiner objected to the disclosure because of an informality on page 7, line 27. Applicants have amended this paragraph, paragraph 46, to correct this typographical error.

Rejections under 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims 1-3 and 8-10 under 35 U.S.C. §112, second paragraph. In particular, the Examiner stated that applicant "should clarify the structure/arrangement of the interface being coupled to the first and second spiral conductive pattern" and "should clarify which surface is intended to receive the first conductive shield member." Applicants have amended claim 1 to clarify these features.

In addition, the Examiner stated that applicant "should clarify the structure of the multiple layer inductor being 'implemented on a substrate'." Applicants do not understand this rejection. The phrase "multiple layer inductor implemented on a substrate" is in the preamble of the claim. The body of the claim defines the elements of the "multiple layer inductor implement on a substrate." Based on the foregoing argument, Applicants respectfully request reconsideration of claims 1, 3, 8 and 10 and withdrawal of the rejection under 35 U.S.C. §112.

Rejections under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-3 and 8-10 under 35 U.S.C. §103 as unpatentable over Tashiro, *et al*, U.S. Patent. 5,515,022 (Tashiro) in view of Kimura, *et al*, JP 62-152111 (Kimura). Applicants respectfully traverse this rejection.

As the Examiner correctly points out, Tashiro does not describe the shielding structure of Applicants' invention. However, the Examiner states in the Office Action that

Kimura "discloses at least one conductive shield member [1A] sandwiching the coil structure." Because the Kimura reference is published in Japanese, Applicants could only use the one sentence translation of the Purpose section, the one paragraph translation of the Constitution section, and Figures 1-3 to address the Examiner's rejection. Based on this information, Applicants disagree with the Examiner's understanding of Kimura.

Although, the translation refers to layer 1A as the "electromagnetic shielding conductor layer," neither FIG. 1 nor the Constitution show or describe a conductive shield pattern having a common voltage potential (e.g., ground), as recited in claim 1. In fact, the layer 1A in Kimura shows only coil electrodes 8A and 8B (See Constitution and FIG. 1), and does not indicate the common voltage potential as recited in claim 1. Accordingly, the combination of Tashiro and Kimura and does not recite each and every feature of the claim 1.

Furthermore, it would be improper to modify layer 1A of Kimura to have a common voltage potential, because to do would short out coils 8A and 8B, rendering them inoperable for their intended purpose. Applicants respectfully submit that a reference cannot be modified in an attempt to find applicants' claimed invention unpatentable under 35 U.S.C. 103, if doing so would render the reference inoperable for its intended purpose. (*See* M.P.E.P. 2143.01, citing *In re Gordon*, "if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification"). Accordingly, it is improper to modify layer 1A to be a conductive electromagnetic shield having a common voltage potential because to do so would short out coils 8A and 8B, rendering the disclosure inoperable. Therefore, the recited art combination does not teach each and every feature of the claimed invention, and therefore, does not meet the requirements for prima facie obviousness. Accordingly, Applicants request that the rejection under 35 U.S.C. § 103 be removed and that this claim and its respective dependent claims be passed to allowance.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be

withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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